

The opinion in support of the order being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 37

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**MAILED**

Ex parte WILLIBALD KRAUS

**FEB 28 2002**

Appeal No. 2001-2528  
Application No. 08/230,083

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

**ORDER**

Before STONER, Chief Administrative Patent Judge, HARKCOM, Vice Chief Administrative Patent Judge, and NASE, Administrative Patent Judge.

NASE, Administrative Patent Judge.

This is an order under 37 CFR § 1.196(d). 37 CFR § 1.196(d) provides:

The Board of Patent Appeals and Interferences may require appellant to address any matter that is deemed appropriate for a reasoned decision on the pending appeal. Appellant will be given a non-extendable time period within which to respond to such a requirement.

Thus, 37 CFR § 1.196(d) authorizes the Board of Patent Appeals and Interferences (Board) to require an appellant to clarify the record by addressing any matter deemed appropriate for a reasoned decision on the appeal.

### BACKGROUND

The sole issue on appeal is whether claims 14 and 16 have been properly rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.


The appellant filed their appeal brief on October 4, 2000 (Paper No. 35).


The case of Pannu v. Storz Instruments, Inc., 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), was decided on July 25, 2001.


In Pannu the Court in discussing the recapture rule stated that "[o]n reissue, [patentee] is estopped from attempting to recapture the precise limitation [patentee] added to overcome prior art rejections." 258 F.3d at 1372, 59 USPQ2d at 1601.

### ORDER

Pursuant to 37 CFR § 1.196(d), the appellant is required to file a Supplemental Appeal Brief to address the impact the Pannu decision has on the rejection before us in this appeal.

  
BRUCE H. STONER, JR.  
Chief Administrative Patent Judge

  
GARY V. HARKCOM  
Vice Chief Administrative Patent Judge

  
JEFFREY V. NASE  
Administrative Patent Judge

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FAY, SHARPE, BEALL, FAGAN,  
MINNICH & MCKEE  
1100 SUPERIOR AVE., STE 700  
CLEVELAND, OH 44114-2518

JVN/tdl